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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,862	02/09/2004	Shinji Ohnishi	1232-5280	9502
27123	7590	03/27/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			SUN, SCOTT C	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

JS

Office Action Summary	Application No.	Applicant(s)	
	10/774,862	OHNISHI, SHINJI	
	Examiner	Art Unit	
	Scott Sun	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 2/9/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergsten (US Patent #6,345,368) in view of Her et al (US Patent #5, 634,040).

3. Regarding claim 1, Bergsten discloses a storage device (storage controllers and MSDs) comprising: a detecting unit (host device I/F, figure 3) adapted to detect whether the storage device has been connected to an information processing apparatus (host); and a first operating mode (figure 10, decision step 1006), in which the storage device operates as a storage device dedicated to the information processing apparatus if the storage device has been connected to the information processing apparatus, (figure 10; column 11, lines 18-20); and a second operating mode, in which the storage device operates as a file server if the storage device has not been connected to the information processing apparatus (column 4, lines 32-44; column 4, line 64 - column 5, line 5).

Examiner notes the storage devices are accessed by all the hosts connected to the network (figure 1). Accordingly the storage system is a file server (or network attached storage). In addition, Bergsten teaches the storage controller transfers data to hosts by

setting up exclusive use of the bus, therefore it operates as a storage device dedicated to the host.

Bergsten does not disclose expressly a selecting unit to select the operating modes. However, Her discloses a selecting unit (figure 1, transmission controller 108) that selects different transmission modes (figure 2; column 4, line 60 – column 5, line 27). Teachings of Bergsten and Her are from the same field of storage devices, and particular to storage devices connected to a network.

Therefore, it would have been obvious at the time of invention to combine teachings of Bergsten and Her by using the transmission controller and associated circuitry in the system of Bergsten for the benefit of efficient transfer of multimedia data (Her; column 2, line 63-65).

4. Regarding claim 2, Bergsten and Her combined disclose claim 1, and Her further discloses a communication unit (data processor 102 and communication connector 100) adapted to enable communication with an access point (network terminal) in a network (column 4, lines 35-37, 45-49), wherein said communication unit is disabled if the first operating mode has been selected (column 6, lines 7-13). Examiner notes that Her teaches cutting off communication between storage and the network, effectively disabling the communication unit.

5. Regarding claim 3, Bergsten and Her combined disclose claim 1, and Her further teaches the selecting unit performs the selection of the first and second operating modes automatically based upon result of detection by said detecting unit (column column 6, lines 7-13). Examiner notes that Her teaches when no network data is

detected, the transmission controller cuts off the network communication with the storage. In combining teachings of Her and Bergsten, one of ordinary skill in the art would readily recognize that because Bergsten teaches transferring data to hosts by giving the host exclusive use of the connection, network access can be disabled as taught by Her.

6. Regarding claim 4, Bergsten and Her combined disclose claim 3, and Bergsten further discloses wherein said first operating mode has a priority higher than that of the second operating mode, and in a case where said detecting unit has detected connection to the information processing apparatus, the storage device operates in the first operating mode even in an environment in which the storage device is capable of operating in the second operating mode (figure 10; column 11, lines 18-20). Examiner notes that because the host has exclusive use of the communication link, transferring data between the storage device and the host has the higher priority than other transfers over the communication link.

7. Claims 5-10 are substantially similar to claims 1-4, and the same rejection is applied.

Conclusion


8. Other publications are cited to further show the state of the art with respect to storage devices capable of being connected and disconnected from a network. Refer to form 892, "Notice of References Cited", for a complete list of relevant prior arts cited by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Sun whose telephone number is (571) 272-2675. The examiner can normally be reached on M-F, 10:30am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS



KIM HUYNH
SUPERVISORY PATENT EXAMINER

3/19/06